

Applicant: Y. Kamezaki, et al.  
U.S.S.N. : 09/815,257  
RESPONSE TO FINAL OFFICE ACTION  
Page 31 of 36

### **REMARKS**

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-58 are pending in the subject application.

Claims 1-23 and 27-42 are acknowledged as being allowable by the Examiner.

Claims 24-26 and 43-58 stand rejected under 35 U.S.C. §102, 35 U.S.C. §103 and/ or 35 U.S.C. §112, second paragraph. The Examiner did indicate that claims 44-58 would be allowable if appropriately re-written to overcome the 35 U.S.C. §112 rejections. Claim 29 was objected to because of an identified informality.

Claims 24 and 43 were amended as suggested by the Examiner.

Claim 29 was amended to address the identified informality.

Claim 44 and 54 were amended so as to address the 35 U.S.C §112 rejections.

The amendments to the claims are supported by the originally filed disclosure.

### **35 U.S.C. §102 REJECTIONS**

The Examiner rejected claim 43 under 35 U.S.C. §102(b) as being anticipated by Osamu [JP 2585463]. Applicants respectfully traverse as discussed below. Because claim 43 was amended in the instant amendment, the following discussion refers to the language of the amended claims. However, only those amended features specifically relied upon to distinguish

Applicant: Y. Kamezaki, et al.  
U.S.S.N. : 09/815,257  
RESPONSE TO FINAL OFFICE ACTION  
Page 32 of 36

the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

As indicated herein Applicants Amended claim 43 as suggested by the Examiner to include language relative to suspending operation to decrease power consumption. In view of the amendments to claim 43, Applicants believe that this claim is distinguishable from the cited art. Applicants also refer to the comments that follow in connection with the §103 rejection as to the disclosures and teachings of Osamu.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, "The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). It is clear from the foregoing remarks that the above identified claims are not anticipated by Osamu.

It is respectfully submitted that for the foregoing reasons, claim 43 is patentable over the cited reference and thus, satisfy the requirements of 35 U.S.C. §102(b). As such, claim 43, including the claims dependent therefrom is allowable.

Applicant: Y. Kamezaki, et al.  
U.S.S.N. : 09/815,257  
RESPONSE TO FINAL OFFICE ACTION  
Page 33 of 36

### 35 U.S.C. §103 REJECTIONS

The Examiner rejected claims 24-26 under 35 U.S.C. §103 as being unpatentable over Osamu [JP 2585463] in view of Taku [JP 11-184434] for the reasons provided on pages 4-5 of the above-referenced Office Action. Applicants respectfully traverse. Because claims were amended in the instant amendment, the following discussion refers to the language of the amended claims, however, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

As indicated above, claim 24 was amended as suggested by the Examiner to indicate that the deactivated condition corresponds to a shutdown/ turned off condition so the shutdown/ turned off portions do not consume power as well as thereby rendering the driving section incapable of providing output signals until the driving section is turned on when the next display is to be carried out. As such, Applicants respectfully submit that claim 24 is allowable.

As each of claim 25-26 depend from claim 24, Applicants also submit that at least because of the dependency from an allowable base claim, each of claims 25-26 also are considered to be allowable.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5

Applicant: Y. Kamezaki, et al.  
U.S.S.N. : 09/815,257  
RESPONSE TO FINAL OFFICE ACTION  
Page 34 of 36

USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the forgoing discussion regarding the disclosures of the cited references, there is no reasonable expectation of success provided in the reference(s).

It is respectfully submitted that for the foregoing reasons, claims 24-26 are patentable over the cited reference(s) and thus, satisfy the requirements of 35 U.S.C. §103. As such, these claims are allowable.

Applicant: Y. Kamezaki, et al.  
U.S.S.N. : 09/815,257  
RESPONSE TO FINAL OFFICE ACTION  
Page 35 of 36

CLAIMS 44-58

The above-referenced Office Action provides that claims 44-58 would be allowable if they were amended to overcome the rejections under 35 U.S.C. §112, second paragraph. The Office Action further provides that claims 45-53 and 55-58 stand rejected because of their dependency from a rejected claim with an identified concern.

As provided above, claims 44 and 54 were amended to resolve the Examiner's rejections under 35 U.S.C. §112, second paragraph.

Accordingly, claims 44-58 are considered to be in allowable form.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Applicants believe that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed

Applicant: Y. Kamezaki, et al.  
U.S.S.N. : 09/815,257  
RESPONSE TO FINAL OFFICE ACTION  
Page 36 of 36

for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit  
Account No. 04-1105.

Respectfully submitted,  
Edwards & Angell, LLP

Date: April 7, 2005

By: William J. Daley, Jr.  
William J. Daley, Jr.  
(Reg. No. 35,487)  
P.O. Box 9169  
Boston, MA 02209  
(617) 439- 4444

Bos2\_479746.1